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EXAMINER

D'AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/720,029	DEEDS, DOUGLAS	
	Examiner	Art Unit	
	Stephen M. D'Agosta	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-24 and 26-32 is/are rejected.
- 7) ☒ Claim(s) 15, 16, 25 and 33 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed **terminal disclaimer** in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-33 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 7,020,497. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both deal with presenting a selected ring tone/tune (eg. from a group of possible stored ring tones/tunes) based upon an in-coming call event/characteristic.

Drawings

Figures 1-2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

> The examiner notes that there doesn't appear to be anything unique about the figures shown with respect to the claims, other than these components, in general, just support the operation claimed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term concept of the "enhanced ring tune" as put forth by the applicant has several meanings, eg. it can be a change to the original tune (eg. tempo change, volume change, timbre change, instrument changes, etc) or potentially a different ring tune attached to the first. The term "ring tune", while most quickly identified with a musical tune, is interpreted as just a data file that can be downloaded to enhance the base ring tune, hence this data file need not only be limited to music (eg. it could be a spoken voice with no music). Further to this point, the examiner has found art that appends a data file (eg. user's recorded voice) which identifies the calling party to the

called party. Hence a recorded name is appended to the ring tone when the called party's phone is rung.

The examiner puts forth this USC 112 rejection for the express purpose of having the applicant more specifically define their "enhancing concept" to rule out the possibility of spoken voice, since that would read on the applied prior art. Just how the claims should be amended is left to the applicant, eg. at the very least, the claim should state that the ring tune is defined as a "musical ring tune", so that the enhancement cannot be a data file which is spoke announcements.

As a secondary point, the examiner notes that it is well known in the art for phones to have different settings, eg. meeting, outside, inside, whereby the tone/volume of the ring/ring tone can be adjusted/enhanced based on receiving an incoming call (See prior art Schmidt).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 11-12, 17-19, 21-23 and 26-29 and 31 rejected under 35

U.S.C. 103(a) as being unpatentable over Lin et al. US 6,366,791 and further in view of Speeney et al. US 6,570,983.

As per **claims 1, 19, 22 and 26**, Lin teaches a method for providing a ring-tune alert in a communication device operable to receive communications via a communication network (title, abstract and figures 1-2 show music #55 being sent), said method comprising the steps of:

detecting an incoming communication;

determining at least one communication characteristic of the incoming communication;

associating a first ring-tune enhancement with the at least one communication characteristic; and

generating a ring-tune alert (C5, L3-19 teaches detecting an incoming call and the caller's ID wherein said caller's ID is associated with a ring tone/tune and it is played to distinguish that caller from another caller, eg. caller X and caller Y will cause the phone to ring differently) **but is silent on** applying the first ring tune enhancement to a base ring tune.

Speeney teaches appending an audible announcement of the caller's identity to the base ring tone (eg. the phone rings and then the identity is announced) (abstract and C2, L25-46), which reads on an enhancement to the first ring tone since they are both played to alert the user.

With further regard to claim 19, Lin teaches a processor in either the phone or network which performs the identification of the incoming caller and selects the appropriate ring tone.

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that applying the first ring tune enhancement to a base ring tune, to provide means for varying the ring tune based on the caller's identity.

As per **claims 2-3**, the combination teaches claim 1 **but is silent on** further comprising the step of annunciating the enhanced ring tune and it is audible.

Lin does teach that the ring tune is played audibly (C5, L3-19 teaches the music tune is played).

Speeney teaches audibly announcing the caller's ID (C2, L25-46).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that it annunciates the enhanced ring tune and it is audible, to provide means for the user to hear the caller's identity.

As per **claim 4**, the combination teaches claim 1, further comprising the step of initializing a ring-tune database by storing the first ring-tune enhancement and the base ring tune (C3, L30-57 teaches the multiple ring tunes have been downloaded and figure 5 #65a/b shows tune stored in phone -- hence a caller's number that is **not** recognized will receive one (default) ring tune while any caller whose number is matched will receive their distinctive ring tune).

As per **claim 5**, the combination teaches claim 4, wherein the initializing step comprises downloading ring-tune information from an Internet-based server (figure 2 shows a web server #40 downloading music tunes to the phone, C3, L30 thru C4, L29).

As per **claims 6 and 29**, the combination teaches claim 1/26 **but is silent on** wherein the first ring-tune enhancement comprises appending a secondary ring-tune to the base ring tune.

Speeney teaches appending secondary file to the base ring tune to identify the caller (C2, L25-46).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the first ring-tune enhancement comprises appending a secondary ring-tune to the base ring tune, to provide means for the user to hear both the typical ringing tune/alert along with an added enhancement (eg. the caller's identity).

As per **claim 7**, the combination teaches claim 6, **but is silent** wherein the secondary ring-tune is a preamble appended in front of the base ring tune.

Speeney teaches appending secondary file to the base ring tune to identify the caller (C2, L25-46). One skilled would be able to position the secondary attachment to either the front or back of the base ring tune.

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the secondary ring tone is appended to front/back, to provide means for the user to either hear first (or second) the caller's identity.

As per **claims 8 and 31**, the combination teaches claim 1/26, **but is silent on** wherein the first ring-tune enhancement comprises the addition of at least one accompaniment part to the base ring tune.

Speeney teaches appending secondary file to the base ring tune to identify the caller (C2, L25-46).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the first ring-tune enhancement comprises the addition of at least one accompaniment part to the base ring tune, to provide means for adding a caller's identity to the base ring tone.

As per **claim 11**, the combination teaches claim 1, wherein the base ring tone is one of a plurality of base ring tunes selectable for application (C3, L30 thru C4, L29 teaches downloading ring tunes which can be used as either base tunes or distinctive tunes, as selectable by the user).

As per **claim 12**, the combination teaches claim 11, wherein the selection of a base ring tune from the plurality of base ring tunes is a function of the at least one communication characteristic of the incoming communication (C5, L3-20 teaches the caller's ID being used to determine which ring tune to use, eg. caller ID is a communication characteristic of the incoming call).

As per **claims 17 and 27**, the combination teaches claim 1/26, wherein the communication device is a mobile station operable within a wireless communication network (see figures 1-2).

As per **claims 18 and 28**, the combination teaches claim 1/26, wherein the communication device is a computer operable to receive communications via a connection to the Internet (see figure 2, shows web server, mobile unit and user computer).

As per **claim 21**, the combination teaches claim 19, **but is silent on** wherein the least one ring tune enhancement stored in the ring-tune database comprises a plurality of ring-tune enhancements for associating with communication characteristics.

Speeney teaches appending multiple audible announcements which are selected from a database (C2, L25-46).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that at least one ring tune enhancement stored in the ring-tune database comprises a plurality of ring-tune enhancements for associating with communication characteristics, to provide means for using a database to cross reference the ring tunes to a specific person/caller.

As per **claim 23**, the combination teaches claim 22, wherein the ring-tune generator is resident in the at least one mobile station and wherein the ring tune controller is not located in the mobile station, and further comprising means for the ring-tune controller to direct the ring-tune generator, via wireless communication, to generate the enhanced ring tone (C3, L12-20 teaches downloading whereas C4, L39-55 teaches storing the ring tune in the network).

Claims 9, 20 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Lin/Speeney and further in view of Schmidt et al. US 6,363,258.

As per **claims 9 and 30**, the combination teaches claim 1/26, **but is silent on** wherein the first ring-tune enhancement comprises application of a tonal adjustment to the base ring tune.

Schmidt teaches changing the tone (eg. volume) of the call based on the calling party who is calling:

"...While the response of the Enhanced Terminal type mobile terminals 20 has been described in terms of whether to auto-answer the group call or not, other responses are also possible. For instance, based on the information provided by the indicator

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flags, the mobile terminals 20 of the present invention may vary information displayed on their displays 28 or change their alert signals (e.g., ring tone, ring volume, vibrations generated, etc.) depending on the characteristics of the incoming group call. Just by way of example, the mobile terminal may loudly ring with a particular tone when a group call with alert priority is detected, and "Alert" may be indicated on the display 28, while group calls of Sequential subtype with normal priority may only result in a low level vibration and a display of the caller ID. Of course, these responses of the mobile terminal 20 may be pre-set at the factory or may be user selectable to provide maximum flexibility.."

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the first ring-tune enhancement comprises application of a tonal adjustment to the base ring tune, to provide means for changing the ring tone in several different manners for different situations.

As per **claim 20**, the combination teaches claim 19, **but is silent on** wherein the mobile station comprises a vibration generator, and wherein the first ring-tune enhancement comprises the addition of a vibrating effect to the base ring-tune.

Schmidt teaches modifying the ring (eg. ring with vibration) based on the calling party (C10, L34-50).

"..While the response of the Enhanced Terminal type mobile terminals 20 has been described in terms of whether to auto-answer the group call or not, other responses are also possible. For instance, based on the information provided by the indicator flags, the mobile terminals 20 of the present invention may vary information displayed on their displays 28 or change their alert signals (e.g., ring tone, ring volume, vibrations generated, etc.) depending on the characteristics of the incoming group call. Just by way of example, the mobile terminal may loudly ring with a particular tone when a group call with alert priority is detected, and "Alert" may be indicated on the display 28, while group calls of Sequential subtype with normal priority may only result in a low level vibration and a display of the caller ID. Of course, these responses of the mobile terminal 20 may be pre-set at the factory or may be user selectable to provide maximum flexibility.."

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It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that it uses a vibration generator, and wherein the first ring-tune enhancement comprises the addition of a vibrating effect to the base ring-tune, to provide multiple different ways in which to alert the mobile user to the call.

Claims 10, 24 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Lin/Speeney and further in view of Narinen et al. US 2002/0115456.

As per **claims 10 and 32**, the combination teaches claim 1/32, **but is silent on** wherein the first ring-tune enhancement comprises application of a stylistic adjustment to the base ring tune.

Narinen teaches modifying ring tones on a phone whereby changes to the tone include style changes (see abstract and Paragraph #6).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that wherein the first ring-tune enhancement comprises application of a stylistic adjustment to the base ring tune, to provide means for changing the ring tone in several different manners for different situations.

As per **claim 24**, the combination teaches claim 22, **but is silent on** wherein the at least one enhancement is a tempo enhancement.

Narinen teaches modifying ring tones on a phone whereby changes to the tone include tempo changes (see abstract and Paragraph #6).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that the at least one enhancement is a tempo enhancement, to provide multiple ways in which to modify the base ring tune to alert the user to a call.

Claim 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Lin/Speeney and further in view of Moss et al. US 2002/0176554.

As per **claim 13**, the combination teaches claim 1, **but is silent on** wherein this step of determining at least one communication characteristic comprises the step of transmitting a request for communication-characteristic information AND the step of receiving a response to the request for communication-characteristic information.

Moss teaches requesting caller ID data and providing it to the phone:

[Para 0013] FIG. 1 is a block diagram of a telephone system 20 capable of implementing the invention in accordance with one embodiment of the invention. A destination service switching point (SSP) 22 has a plurality of destination numbers 24. The destination SSP 22 is connected to a switching control point (SCP) 26 by a signaling system seven (SS7) link 28. The SCP 26 has a caller ID with name database 30 and a custom caller ID with name database 32. Standard caller ID with name service results in a trigger when a call is placed to a telephone number 24 subscribing to the service. The SSP 22 sends a query to the SCP 26 requesting caller ID information. The SCP 26 does a lookup on the caller ID with name database 30 and passes the caller's name, telephone number, date and time to the customer's telephone. Unfortunately, as explained above, the customer only receives an organization's name when the call is placed from an organization. Part of the reason for this is that large organizations lease a group of telephone numbers and hand these out to employees. As a result, the service provider does not have the name information. In addition, organizations have a tendency to move employees to new telephone numbers regularly.

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that determining at least one communication characteristic comprises the step of transmitting a request for communication-characteristic information AND the step of receiving a response to the request for communication-characteristic information, to provide means for the phone to receive caller ID info so that it can be used to select a ring tune based on said caller ID.

Allowable Subject Matter

Claims 15-16, 25 and 33 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

claim 15: The prior art does not teach “wherein the response contains communication-characteristic information and further comprising the step of storing the communication-characteristic information for future use in associating ring-tune enhancements with communication characteristics”.

claim 16: The prior art does not teaches “the step of generating a designated ring-tune alert for indicating the arrival of an incoming communication for which no communication characteristic could be associated with a ring-tune enhancement”.

claim 25: The prior art does not teaches “the system monitors the number of incoming-call notifications from the same source, and wherein the tempo enhancement is a function of the number of unsuccessful call attempts made by the same source”.

claim 33: The prior art does not teach “wherein the at least one communication characteristic comprises a plurality of communication characteristics, and further comprising a fifth executable code portion for associating a predetermined ring-tune enhancement with each of a plurality of the plurality of communication characteristics”.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


1. Lee US 6,418,330
2. Deeds US 2004/0219953
3. Kim US 5,881,147
4. Grundvig et al. US 6,434,394

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

STEVE M. D'AGOSTA
PRIMARY EXAMINER



6-20-06